

REPLY UNDER 37 C.F.R § 1.116
EXPEDITED PROCEDURE
TECHNOLOGY CENTER 3600
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : Henrik Przybilla
For : DIGITAL RIGHTS MANAGEMENT
: UNIT FOR A DIGITAL RIGHTS
: MANAGEMENT SYSTEM
Serial No. : 10/577,087
Filed : April 24, 2006
Art Unit : 3685
Examiner : James D. Nigh
Atty. Docket : AT03 0059 US1
Confirmation No. : 1182

PRE-APPEAL BRIEF REQUEST FOR REVIEW

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Sir:

This Pre-Appeal Brief Request for Review responds to the Final Office Action dated March 8, 2010 and is filed concurrently with a Notice of Appeal. Applicant hereby requests review of the rejections in the above-identified application in view of the concurrently-filed Notice of Appeal. Claims 8-27 are pending in the present application, of which claims 8-10 are independent.

On pages 6 and 7, the Office Action rejects claims 10, 21, and 22-27 under 35 U.S.C. § 101 as allegedly directed to non-statutory subject matter. Applicant respectfully submits that these rejections are clearly improper.

On page 7, the Office Action alleges that *In re Bilski* established a rule that a "tie to a particular apparatus, for example, cannot be mere extra-solution activity."

In response, Applicant respectfully submits that the Examiner's characterization of *In re Bilski* is incomplete, at least because it only refers to the first page of that decision. *In re Bilski*, 545 F.3d 943, 88 U.S.P.Q.2d 1385 (Fed. Cir. 2008). Regarding "extra-solution activity," footnote 14 of *In re Bilski* relied upon on prior decisions: *In re Schrader*, 22 F.3d 290, 294 (Fed. Cir. 1994) (holding a simple recordation step in the middle of the claimed process incapable of imparting patent-eligibility under § 101); *In re Grams*, 888 F.2d 835, 839-40 (Fed. Cir. 1989) (holding a pre-solution step of gathering data incapable of imparting patent-eligibility under § 101).

Applicant respectfully submits that the Office Action's conclusion is improper as it fails to specifically define the alleged "extra-solution" activity, or to match the facts in *Schrader* or *Grams*. Instead, page 7 of the Office Action presents a conclusory statement, declaring that "e.g. authenticating the DRM user device to the DRM server device" is "representative" of extra solution activity. The use of a single alleged example is not believed to follow the guidance that "the machine-or-transformation test, properly applied, is the governing test for determining patent eligibility of a process under § 101." *In re Bilski*, 545 F.3d at 956.

Applicant respectfully submits that the machine-or-transformation test was improperly applied in the rejection. "A claimed process is surely patent-eligible under § 101 if: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing." *In re Bilski*, 545 F.3d at 954 (emphasis added). Here, claim 10 is tied to several examples of a "particular machine or apparatus": a DRM system, a plurality of DRM client devices, a DRM server device, and a DRM user device. The Office Action fails to comply with *In re Bilski* by failing to ascertain whether any of these items are particular machines. Moreover, there is absolutely no legal support for the Examiner's position on page 3 that the preposition "by" is statutory while the preposition "with" is non-statutory. It should be noted that "by" and "with" are synonyms and there is no reason to

make the change (e.g. see Merriam Webster: "using the means or agency of <was able to finish the project *with* her help> — see **BY**").

On pages 7-9, the Office Action rejects claims 8, 9, and 11-20 under 35 U.S.C. § 112, second paragraph as allegedly indefinite. The rejection is believed faulty for at least two reasons.

First, the Examiner alleges that the scope of claim 8 "cannot be ascertained." According to MPEP § 2173.06, where there is a great deal of confusion about the interpretation of the limitations of a claim, it would not be proper to reject such a claim on the basis of prior art (emphasis added). As stated in *In re Steele*, 305 F.2d 859, 134 U.S.P.Q. 292 (C.C.P.A. 1962), "a rejection under 35 U.S.C. § 103 should not be based on considerable speculation about the meaning of terms employed in a claim." Thus the prior art rejection contradicts this rejection.

On page 2, the Examiner incorrectly applies legal precedents related to "recitations of intended use," failing to consider that a patent applicant is free to recite features of an apparatus functionally. "We take the characterization "functional", as used by the Patent Office ... to indicate nothing more than the fact that an attempt is being made to define something (in this case, a composition) by what it *does* ... In our view, there is nothing intrinsically wrong with the use of such a technique in drafting patent claims." *In re Swineheart*, 439 F.2d 210, 212, 169 U.S.P.Q. 226, 228 (C.C.P.A. 1971) (emphasis added).

Second, the Office Action alleges that claims 8 and 9 recite "both an apparatus and a method." In response, Applicant respectfully submits that the Examiner has incorrectly applied the law because no alleged method steps are even identified for either claim. Thus, these claims do not present a single claim which claims both an apparatus and the method steps of using the apparatus, as any basis for indefiniteness under 35 U.S.C. 112, second paragraph. See *IPXL Holdings v. Amazon.com, Inc.*, 430 F.2d 1377, 1384, 77 U.S.P.Q.2d 1140, 1145 (Fed. Cir. 2005) and *Ex parte Lyell*, 17 U.S.P.Q.2d 1548 (B.P.A.I. 1990).

On pages 9-15, the Office Action rejects claims 8-11, 13-16, 18-20, and 24-26 under 35 U.S.C. § 103(a) as allegedly unpatentable over Pub. No. US2004/0103312 to Messerges ("Messerges") in view of Pub. No. US2004/0117440 to Singer et al ("Singer"). On pages 15-19, the Office Action rejects claims 12, 17, 21-23, and 27 under 35 U.S.C. § 103(a) as allegedly unpatentable over Messerges in view of Singer, further in view of secondary references.

In response, Applicant respectfully submits that these rejections fail to comply with MPEP 2142 and have not presented a *prima facie* case of obviousness. Analysis supporting a rejection under 35 U.S.C. § 103 should be made explicit, as "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988, 78 U.S.P.Q.2d 1329, 1336 (Fed. Cir. 2006). See also *KSR*, 550 U.S. 398, 82 U.S.P.Q.2d 1396 (2007) (quoting Federal Circuit statement with approval). In this case, the Office Action is replete with conclusory statements and lacks any articulated reasoning that possesses the legally required rational underpinning.

As set forth in MPEP § 2143.03, "all words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970). Here, the Office Action repeatedly ignores words in the claims, alleging that they are either "intended use" or "non-functional descriptive material." The Examiner fails to present any support for these allegations, instead solely relying upon conclusory statements.

As set forth in MPEP § 2111, the broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. *In re Cortright*, 165 F.3d 1353, 1359, 49 U.S.P.Q.2d 1464, 1468 (Fed. Cir. 1999). In this case, the rejection's interpretation is unreasonable because it assumes that any language "does not distinguish the claimed invention from the

prior art" without specifically addressing all of the claim language. There is no support for the Examiner's repeated omissions of relevant claim language.

As set forth in MPEP § 2111.02, "the determination of whether a preamble limits a claim is made on a case-by-case basis in light of the facts in each case; there is no litmus test defining when a preamble limits the scope of a claim." *Catalina Mktg. Int'l v. Coolsavings.com, Inc.*, 289 F.3d 801, 808, 62 U.S.P.Q.2d 1781, 1785 (Fed. Cir. 2002). Here, the rejection entirely ignores the preamble, assuming, without any justification, that it has no impact on the scope of the claims.

Also, during examination, "statements in the preamble reciting the purpose or intended use of the claimed invention must be evaluated to determine whether the recited purpose or intended use results in a structural difference ... between the claimed invention and the prior art. If so, the recitation serves to limit the claim." *In re Otto*, 312 F.2d 937, 938, 136 U.S.P.Q. 458, 459 (C.C.P.A. 1963) (emphasis added). Applicant respectfully submits that no such evaluation is presented.

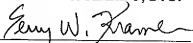
In view of the remarks above, Applicant believes that all of the rejections have been overcome and the application is in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is asked to contact the attorney overseeing the application file, Juergen Krause-Polstorff, of NXP Corporation at (408) 474-9062.

In the event that the fees submitted prove to be insufficient in connection with the filing of this paper, please charge our Deposit Account Number 50-0578 and please credit any excess fees to such Deposit Account.

Date: April 19, 2010
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Respectfully submitted,
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